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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,648	04/13/2000	Zeling Cai	ORT1224	6532

7590 03/22/2002

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EXAMINER

NOLAN, PATRICK J

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 03/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/548,648

Applicant(s)
Cai et al.

Examiner
Patrick J. Nolan

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 9/27/01 and 1/14/02

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1, 3, 5, and 6 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1, 3, 5, and 6 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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DETAILED ACTION

1. The request filed on 1/14/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/548,648 is acceptable and a CPA has been established. An action on the CPA follows.

2. Claims 1, 3, 5, and 6 are pending and being acted upon.

3. Applicant's amendment and response, filed 11/13/01, is acknowledged.

4. Applicant has claimed the benefit of priority to provisional application no. 60/128,596. However, said provisional application was filed more than one year prior to the filing of the instant application (4/09/99), thus, the benefit of priority to said provisional application is denied.

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

A) The residence address of Inventor Sepulveda has not been disclosed,

B) An incorrect date, April 16, 1999, for provisional application 60/128,596 has been disclosed. The correct date is April 09, 1999.

A new declaration properly executed by all inventors is required. See MPEP §§ 608.04(b).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless --.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 5, and 6 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gallimore et al. (of record), for the reasons set forth in Papers No. 6 and 9, mailed 5/25/01 and 8/31/01 respectively.

Applicant's arguments, filed 11/13/01, have been fully considered but they are not persuasive. Applicant argues that the newly added limitation of incubation time "of at least one hour," as well as the requirement that the MHC Class I protein be internalized, separates the instant method from the method taught by the reference because the incubation time of the reference is only 45 minutes and the reference does not teach internalization of the MHC Class I-peptide molecule by the antigen-specific T cell. However, regarding incubation times, the specification discloses at page 5 that after just 30 minutes of incubation "Some of the L^d-GFP aggregates were clearly inside the T-cells," thus teaching that 30 minutes is sufficient time for internalization. As such, the newly added limitation of a time period "of at least one hour," does not render the instant method patentably distinct from the method of the reference. Regarding internalization of the MHC Class I-peptide tetramers of the reference, Whelan et al. (1999) teaches that MHC Class I-peptide tetramers are indeed internalized by antigen-specific T cells (see particularly the Abstract, last sentence). Thus, the internalization requirement of the method of the instant claims is an inherent property of the method of the Gallimore et al. reference.

8. The following are new grounds for rejection.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The specification and the claims as originally filed do not provide support for the invention as now claimed, specifically, a method comprising an incubation period of time, "wherein said period of time is at least one hour."


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Applicant's amendment, filed 11/13/01, asserts that no new matter has been added. Applicant has indicated passages at pages 7-9 of the specification in support of the new limitation. However, said passages disclose only an incubation time "of one hour," other passages disclosing incubation times of 2.5 and 2-4 hours have also been found. However, no support has been found for the broader genus of incubation times comprising times of "at least one hour."

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Patrick J. Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.


Patrick J. Nolan, Ph.D.
Primary Examiner
Technology Center 1600
March 13, 2002